

Line 3, delete " (A,C) " and " (P2) " ;
Line 4, delete " (B, D) " .
Claim 5, line 2, delete " (14) " ;
Line 3, delete " (18, 20) " .
Claim 6, Line 2, delete " (60) " ;
Line 3, delete " (90) " .

REMARKS

I. The Rejection

Claims 1, 3, 5 and 6 were rejected under 35 U.S.C. § 112, second paragraph as indefinite because of the inclusion of reference characters and other notations in parentheses. This rejection has been overcome by deleting every one of the parenthetical characters to which an objection was raised.

Claims 1 – 15, all claims in this application have been rejected under 35 U.S.C. § 102 (e) as unpatentable over Park (US 5,675,424).

2. No Basis for a § 102(e) Rejection

In the Office Action, the Examiner has relied upon a sequence of Figures and text from the Park patent (in order, "fig. 3a", "fig. 4, abstract", "fig. 3a", "abstract, col.2, lines 45+" and "fig. 3a – 3b") as the basis for finding claim 1 to be unpatentable over Park under § 102 (e). However, that section of the statute is directed to situations where the **same** invention (i.e., "the invention") is "described in a patent ---- by another". In that context, it must be noted that Figures 1 – 3B of Park (including all of the figures relied on by the Examiner) are presented by Park under the heading "Description of the Prior Art" (col. 1, line 19 – col. 2, line 30).

By definition, such "prior art" **must** be different from "the invention" described in the remainder of the Park patent and it clearly is not Park's invention. It is therefore inappropriate in the context of a § 102 (e) rejection to attempt to combine portions of Figs. 1 – 3B of Park with other information (e.g. "Abstract") or other figures of Park.

Leaving this issue aside for the moment, the Examiner places

principal reliance upon Park's "prior art" fig. 3a, specifically demultiplexer 13, for a disclosure of

"an interleaving network responsive to said datastream for deriving therefrom multiple datastreams".

In that context, the Examiner states "demultiplexer 13 is equivalent to interleaving network" (of the present claims).

However, unlike the requirement of claim 1 ("an interleaving network responsive to said [MPEG coded] datastream for deriving therefrom multiple datastreams") the prior art demultiplexer 13 described by Park does not "derive" "multiple datastreams" from a single datastream. In fact, demultiplexer 13 does just the opposite by combining (Park says "summing") image data representing a sequence of vertically adjacent stripes or "subpictures P1 through PN" (Park, col. 1, lines 47 – 50 and lines 65 – 67) to form a single datastream. The single datastream is clearly shown in fig. 3a as a single data line labelled "reduced image data" which has been subjected to "summing" (see col. 1, line 66 – col. 2, line 2 and references to "summing" quoted earlier). Still further, Park states (col. 1, lines 50 – 52)::

"the signal process for the overall frame is completed by summing the outputs of the respective encoders."

Thus, "multiple datastreams" clearly are not "derive"(d) by demultiplexer 13 of fig. 3a.

In addition to demultiplexer 13 serving an opposite or inverse function as compared to what is required by claim 1, neither the multiple inputs to demultiplexer 13 nor the single output from demultiplexer 13 is described by Park as "constituted by a predetermined sequence of interleaved image data" as is required by claim 1. In fact, as noted above, the data handled in fig. 3a is that of the adjacent complete "subpicture" stripes of fig. 2. Park describes the combination of the stripes (bottom of col. 1 to top of col. 2) by stating:

"demultiplexer 13 for summing image data of the respective subpictures processed by the respective encoders 12a through 12n and outputting reduced image data corresponding to the overall

frame" (emphasis added).

There is therefore no basis whatsoever for rejecting claim 1 (or any of the dependent claims 2 – 6) based upon Park's showing in fig. 3a (or 3b) of prior art or conventional image encoders which fail to include significant elements of the present claims.

Without referring to any specific ones of the present claims or claim language, the Examiner also appears to take the position that "the limitations claimed (in claim 1 ?) are inherent features ofmultiplexer 74" in fig. 4 of Park. However, multiplexer 74, similarly to demultiplexer 13 of fig. 3a, appears to combine several sets of data into a single output. Thus, the arguments made above regarding the claimed network for "derivingmultiple datastreams" of "interleaved image data" distinguish present claim 1 (and claims dependent on claim 1) from Park's fig. 4 as well.

In the rejection of independent method claim 7, the Examiner states, "Regarding claim 7, limitations claimed are substantially similar to claims 1 and 5, therefore the grounds for rejecting claims 1 and 5 also apply here."

In large part, the distinctions pointed out above regarding "deriving" ("producing" is used in claim 7) "multiple datastreams" from a single datastream serve to distinguish claim 7 from Park as well.

Claim 7 also requires "processing said interleaved data blocks on an interleaved basis" which is not described in Park.

The Examiner has rejected claim 8 (as well as several other claims) based upon an unsupported statement that "first data stream (P1) of interleaved first and second pixel block components and second data stream (P2) of interleaved third and fourth pixel block components ----- are components of an MPEG compatible macroblock."

It is respectfully submitted that no basis has been shown in Park for such a statement and it is therefore requested that it be withdrawn, along with the rejection of claim 8 (and other claims) based on this statement.

Reconsideration and withdrawal of the rejections and objections are respectfully requested in view of the foregoing amendments and the following

remarks.

3. No Proper Basis for Rejections Under 35 U.S.C. § 103(a)

Although the Examiner has rejected the claims under 35 U.S.C. § 102(e) (same invention) reliance has been placed on combinations of prior art and Park's own configuration. If applicable at all, such combinations are only appropriate under 35 U.S.C. § 103(a). However, such a rejection should not apply here either.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine the teachings of a plurality of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicants' own disclosure. In *re* Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing a prima facie case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In *re* Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To support a conclusion that a claimed combination is obvious, either: (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte* Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Where the teachings of various references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the

degree to which one reference might accurately discredit another. In re Young, 18 U.S.P.Q.2d 1089 (Fed. Cir. 1991).

The action does not make out a prima facie case of obviousness with respect to the pending claims.

The Examiner attempted to combine portions of Park's claimed combination with "prior art" disclosed by Park. This attempt is a contradiction of what Park is all about since Park is saying he doesn't suggest using the prior art but rather uses a different approach. Thus, the asserted combinations do not support a prima facie case of obviousness of any of the claims and, especially independent claim 1.

It is respectfully submitted that the suggested combination can be motivated solely by hindsight reasoning guided by applicant's own disclosure — reasoning that is expressly forbidden during the examination of a claim under § 103(a). In re Gorman, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); In re Fritch, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992). Accordingly, reconsideration and withdrawal of the rejections based on combinations of Park with the "prior art" described in Park are respectfully requested.


The rejected, dependent claims are patentable because each includes limitations which are recited in independent claim 1 which have been shown to be patentable. See In re Fine, 5 U.S.P.Q.2d at 1600. Since no prima facie case of obviousness exists with respect to the independent claim, no prima facie case of obviousness exists with respect to any of the dependent claims.

Reconsideration and withdrawal of all rejections are respectfully requested in view of the arguments presented above.

CONCLUSION

In view of all of the foregoing, reconsideration and withdrawal of all of the rejection and allowance of all pending claims 1 –15 are respectfully requested.

Respectfully submitted,

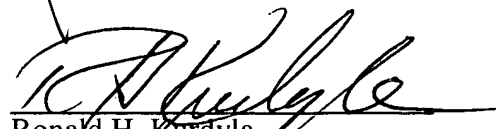

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CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents Washington, D.C. 20231 on:

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Date


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